

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Attorney Docket No. 503177.00387**

In re Application of Stephen A. Smith, et al.      )  
    )  
Application No. 10/676,807      )      Examiner: Stephen J. Castellano  
    )  
Filed October 1, 2003      )      Art Unit 3781  
    )  
For: Ergonomic Disposable Cup Having      )      Confirmation No. 3085  
Improved Structural Integrity      )

**APPELLANT'S APPEAL BRIEF**

MAIL STOP APPEAL BRIEF - PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

This constitutes Applicant's brief on appeal, following a Notice of Appeal mailed on May 4, 2007. As July 4, 2007, is a national holiday, this appeal brief is timely filed. The information specified by 37 C.F.R. 41.37(c) is provided hereunder.

As an initial matter, the Examiner is thanked for the careful analysis that has been given to the claims of the present application and to the cited art. Nonetheless, the Examiner is mistaken in rejecting the claims of the present application. For the reasons that follow, the Examiner's rejections should be reversed.

**I. REAL PARTY IN INTEREST**

The real party in interest is Solo Cup Operating Corporation, the assignee.

**II. RELATED APPEALS AND INTERFERENCES**

A notice of appeal for a co-pending application, Serial No. 11/101,932, which is a continuation of the present application, was filed on June 13, 2007. No decisions have been rendered by a court or the Board in connection with the related appeal.

**III. STATUS OF CLAIMS**

Forty-three (43) claims were originally filed in the application, and three (3) were added in prosecution. Claims 1 and 4-14 are pending for appeal. All pending claims have been rejected. A detailed status of the claims is as follows:

- A. Claims originally filed: 1-43
- B. Claims canceled: 2, 3, 32-42
- C. Claims added: 44-46
- D. Claims currently pending: 1, 4-14
- E. Claims allowed: None
- F. Claims rejected: 1, 4-14
- G. Claims objected to: None
- H. Claims withdrawn: 15-31, 43-46
- I. Claims on appeal: 1, 4-14

The only independent claim in this application is Claim 1. Each of the claims involved in this Appeal (Claims 1 and 4-14) are included in the attached Appendix.

**IV. STATUS OF AMENDMENTS**

No amendments have been entered subsequent to final rejection.

**V. SUMMARY OF THE CLAIMED SUBJECT MATTER**

In making reference herein to various portions of the specification and drawings in order to explain the claimed invention (as required by 37 CFR §41.37(c)(1)(v)), Appellants do not intend to limit the claims. All references to the specification and drawings are illustrative unless otherwise explicitly stated.

**A. Claim 1**

Claim 1 is directed toward a container 10 that is capable of being nested with a similar container. (P. 1, Ln. 6-7; FIG. 9). The container 10 has an open top 12 having an annular rim 14, a base 16, and a sidewall 18 extending between top 12 and the base 16. (P. 7, Ln. 2-3; FIGS. 1, 2). The sidewall 18 has an inner surface 40 and an outer surface 42. (P. 12, Ln. 14-16; FIGS. 4, 5, 9). The sidewall 18 also has a recess 20 and an annular shoulder 22. (P. 8, Ln. 19; P. 9, Ln. 13-14; FIG. 1, 2, 5, 6). The annular shoulder 22 is located between the recess 20 and the base 16. (P. 9, Ln. 13-14; FIGS. 1, 2). The annular shoulder 22 has an arched portion 23. (P. 9, Ln. 14-15; FIGS. 1, 2, 8). The annular shoulder 22 forms an inner stacking surface on the inner surface 40 of the sidewall 18 and the arched portion 23 forms a raised ledge 44 on the inner stacking surface (P. 12, Ln. 14-24; FIG. 9; See also P. 11, Ln. 22-25; FIG. 23). When the container is nested below a second identical container, the base 16 of the second identical container rests upon the inner stacking surface of the first container and the raised ledge 44 of the first container sits within the arched portion 23 of the second identical container. (P. 12, Ln. 14-24; FIG. 9; See also P. 11, Ln. 22-27; FIG. 23).

**VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The following grounds of rejection are to be reviewed on appeal:

1. Whether Claims 1 and 4-14 were properly rejected for non-statutory, obviousness-type double patenting as being unpatentable over U.S. Design Patent Nos. D514,385, D514,380, D508,822, D505,830, D504,593, D499,935, D499,935, D499,934, and D514,884, each individually in view of U.S. Patent No. 3,519,165.

## VII. ARGUMENTS

### A. Rejection of Claims 1 and 4-14 for Non-statutory Obviousness-type Double Patenting Over U.S. Design Patent Nos. D514,385, D514,380, D508,822, D505,830, D 504,593, D499,935, D499,934 and D514,884 (“Appellants’ design patents”) in View of U.S. Patent No. 3,519,165 to Hawley (“Hawley”)

In the Final Office Action, the Examiner rejected Claims 1 and 4-14 for non-statutory obviousness-type double patenting as being unpatentable over U.S. Design Patent Nos. D514,385, D514,380, D508,822, D505,830, D504,593, D499,935, D499,934 and D514,884 (“Appellants’ design patents”) individually in view of U.S. Patent No. 3,519,165 to Hawley (“Hawley”). Appellants elect to argue Claims 1 and 4-14 together as a group.

Appellants respectfully submit that the Examiner’s rejections on these grounds are not proper. More specifically, Appellants submit that (1) the Examiner used an incorrect one-way standard for obviousness determination in rejecting Appellants’ claims, and (2) under the correct two-way standard, a double patenting rejection cannot be established.

#### **1. No Prima Facie Case of Double Patenting Has Been Established Because The Examiner Did Not Use the Proper Two-Way Test for Obviousness**

In considering obviousness-type double patenting, the claims of the patent are compared with the claims in the allegedly conflicting application to determine whether the claims are obvious variants of one another. *See In re Dembiczak*, 175 F.3d 994, 1001, 50 U.S.P.Q.2d 1614, 1619 (Fed. Cir.1999). *See also* M.P.E.P § 1504.06 (noting that double patenting between a design patent and a utility application requires that the design claimed must be able to be recreated “from the utility claims without any reliance whatsoever on the drawings” of the utility application).

The Federal Circuit has clearly established that, in rejecting utility claims for obviousness-type double patenting over a design patent, a two-way determination of obviousness must be made by the Examiner. *Dembiczak*, 175 F.3d at 1002, 50 U.S.P.Q.2d at 1619 (Fed. Cir.1999) (an obviousness-type double patenting rejection is appropriate only if the claims of the

two patents cross-read).<sup>1</sup> See also M.P.E.P §§ 804 and 1504.06 (“However, in design-utility situations, a two-way obviousness determination is necessary for the rejection to be proper”). “The test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa.” *Id.* (citing *Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 939-940, 220 U.S.P.Q. 481, 487 (Fed. Cir. 1983)). The Federal Circuit has also noted that double-patenting between utility and design patents occurs only “in some very rare cases.” *Id.* See also *Carman Indus.*, 724 F.2d at 939-940, 220 U.S.P.Q. at 486-487 (Fed. Cir. 1983) (noting that, since design and utility patents involve different subject matter, design-utility double-patenting presents significant problems in legal theory).

In this case, the Examiner made only a one-way determination of obviousness, asserting that Appellants’ utility claims are obvious in view of Appellants’ design claims. (See Final Office Action at P. 3-4). However, the Examiner did not also determine whether Appellants’ design patents were obvious over the claims of the utility patent application, as required under the proper two-way test. Accordingly, because the Examiner has not even attempted to establish the required two-way determination of obviousness, the Examiner has not established a *prima facie* case of obviousness-type double patenting in the present case.

## **2. Two-Way Obviousness Cannot Be Established With Respect to Claims 1 and 4-14**

Appellants also submit that if the proper two-way obviousness standard is applied, the rejection of Claims 1 and 4-14 for obviousness-type double-patenting cannot be established. In particular, the obviousness of Appellants’ design claims over the present utility claims cannot be established, because the general textual descriptions in Appellants’ utility claims cannot render the specific designs claimed in Appellants’ design patents obvious. The situation in *Dembiczak* is highly analogous to the present case, and thus, the decision in *Dembiczak* is controlling.

---

<sup>1</sup> Appellants note that *Dembiczak* was abrogated in part on other grounds by *In re Gartside*, 203 F.3d 1305, 53 U.S.P.Q.2d 1769 (Fed. Cir. 2000). *Gartside* abrogated *Dembiczak* only with regard to the standard of review, holding that the Board’s factual determinations in an obviousness analysis should be reviewed for “substantial evidence,” rather than “clear error.” *In re Gartside*, 203 F.2d 1305 at 1316, 53 U.S.P.Q.2d 1769 at 1776. Appellants submit that the holding in *Dembiczak* is even more compelling, given that it was formed under the more stringent “clear error” standard of review. See *Dembiczak*, 175 F.3d at 998, 53 U.S.P.Q.2d at 1616.

In *Dembiczak*, the Federal Circuit addressed the Board's rejection for obviousness-type double patenting over two Dembiczk design patents, applying the two-way obviousness test. *See Dembiczk*, 175 F.3d at 1002, 53 U.S.P.Q.2d at 1619. The utility patent application in *Dembiczak* was directed towards a decorative trash bag, and included such elements as:

an outer surface which is premanufactured orange in color for the user to simulate the general appearance of the outer skin of a pumpkin,

and

facial indicia including at least two of an eye, a nose and a mouth on the orange color outer surface for forming a face pattern on said orange color outer surface to simulate the general outer appearance of a decorative pumpkin with a face thereon. *See Dembiczk*, 175 F.3d at 997, 50 U.S.P.Q.2d at 1615.

The Dembiczk design patents which formed the basis for the Examiner's rejection were directed toward a trash bag having a decorative jack-o-lantern face thereon. *Id.* 175 F.3d at 997-998, 50 U.S.P.Q.2d at 1616.

The Federal Circuit reversed the Board's double-patenting rejection of the utility claims and held that an obviousness-type double patenting rejection was not proper, even though the Board had used the proper two-way test. *Id.* 175 F.3d at 1002-1003, 50 U.S.P.Q.2d at 1619-1620. More specifically, the court held that Dembiczk's utility claims did not render obvious the ornamental designs in Dembiczk's design patents, stating:

In order for a design to be unpatentable because of obviousness, there must first be a basic design reference in the prior art, the design characteristics of which are basically the same as the claimed design. The phrase "having facial indicia thereon" found in the claims of the pending utility application is not a design reference that is "basically the same as the claimed design." In fact, it describes precious little with respect to design characteristics. The Board's suggestion that the design details were simply "a matter of design choice" evinces a misapprehension of the subject matter of design patents.... The position adopted by the Board--that a textual description of facial indicia found in the claims of the utility patent application makes obvious the specific designs claimed in the (patentably distinct) Dembiczk design patents--would presumably render obvious, or even anticipate, all design patents where a face was depicted on a bag. But this, of course, is not the law; the textual description cannot be said to be a reference "basically the same as the claimed design," of the design patents at issue here. The Board's conclusion of obviousness is incorrect. *Id.* (internal citations and quotations omitted) (emphasis added).

In the present case, Claims 1 and 4-14 recite general elements such as, "recesses," "annular ribs," "arched portions," and "raised ledges." These general textual descriptions

“describ[e] precious little with respect to design characteristics,” and cannot make the specific designs claimed in Appellants’ design patents obvious because they are not “basically the same as the claimed design[s],” as stated by the court in *Dembiczak*. *Id.* There are a nearly limitless number of ornamental designs for recesses, arched portions, shoulders, etc., just as there are a nearly limitless number of ornamental pumpkin-face designs. Indeed, Appellants’ own design patents illustrate several different designs for many of these features. Thus, as with the pumpkin-face designs in *Dembiczak*, the general recitation of the terms, “recesses,” “annular ribs,” “arched portions,” and “raised ledges,” cannot render obvious the unique ornamental designs of these features claimed in Appellants’ design patents.<sup>2</sup> The additional consideration of Hawley does nothing to render Appellants’ design patents obvious in view of Claims 1 and 4-14, since Hawley does not disclose structures having an ornamental design similar to any of Applicants’ design patents. Accordingly, if the proper two-way standard is applied, no rejection for obviousness-type double patenting can be established with regard to Claims 1 and 4-14.

Further, in *Dembiczak*, the design patents were subject to a restriction requirement during prosecution, because they had had similar, but differently-shaped, “facial indicia,” establishing that these designs were not obvious over each other. *Dembiczak*, 175 F.3d at 1002, 53 U.S.P.Q.2d at 1620. The court in *Dembiczak* noted this fact as further support for the holding that the designs are not rendered obvious by the utility claims. *Id.* Similarly, in this case, some of Appellants’ design patents (e.g., D514,385 and D514,884) are divisional patents that were subject to a restriction requirement during prosecution, establishing that these designs were not obvious variations of the parent application (D505,830). Applying this to the case at hand, if one design claim showing a cup having a base, recesses, and an annular shoulder with arched portions cannot render obvious another design claim showing a different cup containing these same features, then the general textual descriptions, “a base,” “a recess,” “an annular shoulder,” and “an arched portion” cannot render either design obvious. This further supports Appellants’ position that the double patenting rejections of Claims 1 and 4-14 are not proper. Accordingly, Appellants respectfully request the Board to reverse the obviousness-type double patenting rejections of Claims 1 and 4-14.

---

<sup>2</sup> In fact, the textual descriptions recited above in *Dembiczak*’s utility claims are more specifically descriptive than those of the claims presently at issue. For example, *Dembiczak*’s utility claims recited specific elements such as, “forming a face pattern … to simulate the general outer appearance of a decorative pumpkin with a face thereon.”

**VIII. CONCLUSION**

For the foregoing reasons, Appellants respectfully request that the Board reverse the Examiner's rejections of Claims 1 and 4-14 for obviousness-type double patenting, and order that the case be remanded to the Examiner for further prosecution.

Respectfully submitted,

By:   
Gregory G. Schlenz, Registration No. 55,597  
BANNER & WITCOFF, LTD.  
10 South Wacker Drive - 3000  
Chicago, IL 60606  
Telephone: 1-312-463-5000

Date: July 5, 2007

## CLAIMS APPENDIX

1. A container comprising:  
an open top defined by an annular rim;  
a base defining a lowermost surface of the container; and  
a sidewall extending between the top and the base, the sidewall having an inner surface and an outer surface, the sidewall comprising a recess and an annular shoulder located between the recess and the base, the annular shoulder comprising an arched portion, the annular shoulder forming an inner stacking surface on the inner surface of the sidewall and the arched portion forming a raised ledge on the inner stacking surface, wherein the base of a second identical container rests upon the inner stacking surface and the raised ledge sits within the arched portion of the second identical container when the second identical container is nested upon the container.
4. The container of Claim 1 wherein the annular shoulder further comprises a means for stabilizing the container when the container is held by a user.
5. The container of Claim 1 wherein the recess terminates at the annular shoulder.
6. The container of Claim 1 wherein the sidewall further comprises an annular rib.
7. The container of Claim 1 wherein the sidewall further comprises multiple annular ribs, at least one of the annular ribs comprising a curved portion aligned with the recess.
8. The container of Claim 1 wherein the recess is longitudinal and arcuately formed.
9. The container of Claim 1 further comprising a measurably improved strength to weight ratio over a substantially similar sidewall having no recesses.
10. The container of Claim 1 further comprising an improved strength to weight ratio of at least 3% over a substantially similar sidewall having no recesses.
11. The container of Claim 1 further comprising an improved strength to weight ratio of at least 20% over a substantially similar sidewall having no recesses.
12. The container of Claim 1 further comprising an improved strength to weight ratio of at least 40% over a substantially similar sidewall having no recesses.
13. The container of Claim 1 wherein the sidewall further comprises a lower portion extending between the annular shoulder and the base, the lower portion comprising a beveled portion aligned with the recess.

14. The container of Claim 1 wherein the sidewall further comprises a lower portion extending between the annular shoulder and the base, the lower portion comprising a beveled portion aligned with the arched portion.

**EVIDENCE APPENDIX**

None.

**RELATED PROCEEDINGS APPENDIX**

No decision has been rendered regarding the appeal of co-pending application, Serial No. 11/101,932.